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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,855	04/06/2001	Krister Draxo	7112	8864

7590

09/08/2004

JOHNS MANVILLE INTERNATIONAL, INC.

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EXAMINER

BOYD, JENNIFER A

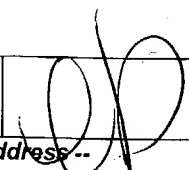
ART UNIT

PAPER NUMBER

1771

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/827,855	Applicant(s) DRAXO ET AL.	
	Examiner Jennifer A Boyd	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) 1,4 and 11-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-3,5-10,16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

***Response to Amendment***

1. The Applicant's Amendments and Accompanying Remarks, filed June 23, 2004, have been entered and have been carefully considered. Claims 1, 16 and 17 are amended, claims 1, 4 and 11 – 15 stand withdrawn and claims 1 – 20 are pending. The invention as currently claimed is not found to be patentable for reasons herein below.

***Claim Rejections - 35 USC § 103***

2. Claims 2 – 3, 5 – 6, 9 and 16 - 20 are rejected under 35 U.S.C. 103(a) as being unpatentable Tucci et al. (US 6,015,570) in view of Fagan (US 4,783,354). The details of the rejection can be found in paragraph 2 of the previous Office Action dated May 4, 2004. The rejection is maintained.

3. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable Tucci et al. (US 6,015,570) in view of Fagan (US 4,783,354), as applied above, and in further view of Sheehan (US 3,640,743). The details of the rejection can be found in paragraph 3 of the previous Office Action dated May 4, 2004. The rejection is maintained.

4. Claims 7 – 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable Narukawa et al. (US 4,148,781) in view of Fagan (US 4,783,354). The details of the rejection can be found in paragraph 4 of the previous Office Action dated May 4, 2004. The rejection is maintained.

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***Response to Arguments***

5. Applicant's arguments filed June 23, 2004 have been fully considered but they are not persuasive.

6. In response to Applicant's argument that Tucci is nonanalogous art, the Examiner respectfully argues the contrary. Tucci discloses that the fabric can be used as wall and floor coverings (column 10, lines 55 – 60). Even if Tucci is implying that the wall covering is only suitable for outdoor use, Tucci is still directed to wall coverings thus making it analogous art.

7. In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., no release layer necessary and designed to be permanently adhered) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. In response to Applicant's argument that the present invention requires 80 – 99 weight % of paraffin wax while Fagan requires a large amount of polymeric materials, the Examiner submits that the use of a higher weight percentage of wax is a result of optimization of the Fagan reference. If the claimed ranges have unexpected results, the burden is upon the Applicant to demonstrate that the claimed ranges are not a matter of simple optimization. The Examiner highly suggests to the Applicant to submit a 37 CFR 1.132 Declaration to establish unexpected results. In the Declaration, the Applicant should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. *In re Hill*, 284 F.2d

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955, 128 USPQ 197 (CCPA 1960) and must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness.

9. In response to Applicant's argument that the presence of polymeric pressure sensitive adhesives would materially affect the basic and novel characteristics of the wax coatings, the Examiner submits that the arguments are not persuasive. The Applicant states that pressure sensitive adhesive *would* affect the basic and novel characteristics of the invention but has not demonstrated *how* the presence of pressure sensitive adhesive would affect the basic and novel characteristics. The Applicant states in the specification that the object of the present invention is "to provide a fiber glass wall covering which can be easily removed from a substrate (e.g., a wall) without requiring any special treatment by the end-user or any special gluing or painting materials". It is unclear that pressure sensitive adhesive would constitute "special treatment" or "special gluing".

10. In response to Applicant's argument that Narukawa does not appear to contain fabrics, the Examiner respectfully argues the contrary. Although, the building sheets may be fiber-reinforced sheets primarily composed of calcium sulfate dihydrate, Narakawa does disclose that the building sheet may also include a glass paper, glass mat or glass cloth (column 4, lines 40 – 45), which can be equated to Applicant's "glass fiber fabric".

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Boyd whose telephone number is 571-272-1473. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jennifer Boyd

April 28, 2004

  
**ULA RUDDOCK**  
**PRIMARY EXAMINER**